

## **REMARKS**

### ***Summary of Changes Made***

Claim 1 has been amended to correct the form of transition in a Markush group and to require the presence of a diluent, and claim 12 has been amended to require the presence of a diluent, as well as correct an antecedent basis issue thus far unnoticed. Accordingly, claims 1-13 remain pending in the application. No new matter has been added by this amendment.

### ***Claim Rejections –Double Patenting (Provisional)***

Claims 1-13 have been provisionally rejected under the judicially created doctrine of double patenting over claims 1-10 of copending Application No. 10/668,041. The Examiner contends that because the presence of mineral oil in claims 1-6 is optional, the claims are not patentably distinct from those of the copending application.

The Examiner will note that claim 1 has been amended to now require the presence of a diluent oil as evidenced by the deletion of "optionally."

The Examiner will note that a Terminal Disclaimer is enclosed herewith, in accordance with 37 C.F.R. 1.130, 1.321(c), and 3.73(b), which disclaims the terminal portion of the term of any patent that issues from the instant application that extends beyond the expiration date of any patent that issues from copending U.S. Application Ser. No. 10/668,041 to Panek et al., ("the '041 application"). Applicants herein assert that the subject matter in the instant application is commonly owned with the subject matter of the aforementioned Panek application. Both the instant application and Panek draw priority from the same provisional application, 60/414,137 filed September 27, 2002. Further, the cited copending '041 application was filed on even date herewith, September 23, 2003, so any double patenting issues would arise only if the term of either patent were extended under the provisions of 35 U.S.C. 154(b). Hence the 35 U.S.C. 102 double patenting rejection is believed moot.

### ***Claim Rejections - 35 U.S.C. §102(b) - Grant***

Next, claims 1-6 were rejected under 35 U.S.C. 102(b) as being anticipated by Grant et al., U.S. 6,011,086 ("Grant I"). There are two Grant patents in the IDS filed

February 2, 2004, the aforementioned '086 patent and U.S. 6,025,075 ("Grant II"); while it is unclear to which Grant patent the Examiner refers, it is irrelevant, inasmuch as the cited portions of the Grant patents are identical.) The reference will hereinafter be called "Grant." The Examiner cites Grant as disclosing the instantly claimed polyolefin homopolymer resin, which may be the propylene homopolymer of instant claim 4, with a nonionic surfactant, which may be a sorbitan ester, as instantly recited in claims 2 and 3. The paragraph bridging columns 2-3 discloses a variety of sorbitan esters. The Examiner draws the reader's attention to Table V in Column 8, which he believes "teaches the concept of [instant] claim 6." The Examiner concludes that, since the compositions are identical, then it follows that the physical properties (i.e., Gardner impact strength) must be inherently identical.

The rejection over Grant is not well founded. In summarizing the Grant patent, the Examiner neglects to mention that the Grant compositions require magnesium hydroxide. Indeed, the Grant patent is entitled "Mixture of Sorbitan Ester, Magnesium Hydroxide and Thermoplastic Resin." The object of the Grant invention is a sorbitan ester coated magnesium hydroxide particle and thermoplastic resins containing a portion of such particles to produce a flame-retardant thermoplastic composition. Taken as a whole, the broadest disclosure of the Grant is a composition comprising a thermoplastic resin, and 25-250 phr of particles of magnesium hydroxide coated in a sorbitan ester. Preferably, the coated magnesium hydroxide will constitute about 50% to about 55% of the total weight of the filled resin, col. 2, ll. 5-12; col. 4, ll. 5-6, 12-13.

Further, the Examiner's assertion that Grant's Table V (column 8) "teaches the concept of [instant] claim 6," is not supported. There is no indication that any composition in the Grant patent, especially those whose properties are shown in Table V, contains either mineral oil or polybutene diluent (or both), as recited in instant claim 1. Table V displays physical properties of blends of polyethylene resin containing magnesium hydroxide coated with a sorbitan ester (filler) wherein the weight ratio of filler to resin is 52:48. In Table V, the tensile strengths range from 1200-1340 psi. The tensile strengths of examples falling within the scope of instant claim 6 (in Tables 9 -11) range from about 4000 psi to about 5300 psi, in samples whose Young's Modulus (i.e., tensile modulus) range from about 160 kpsi to about 270 kpsi. The instantly claimed

compositions have a tensile strength of about 3 times as great as the Grant compositions. Based on the foregoing, the compositions are not the same.

Based on these distinctions, it is believed that the patentability of claims 1-6 over Grant has been established, and a notice to that effect is respectfully requested.

***Claim Rejections - 35 U.S.C. §102(b) - Jochmann***

Claims 10-11 were rejected under 35 U.S.C. 102(b) as being anticipated by Jochmann et al. U.S. 5,331,022 ("Jochmann"). The Examiner asserts that Jochmann, at column 2, lines 51-64, discloses the mixture of instant claims 10 and 11

Broadly, Jochmann discloses a method of reducing radon in enclosed spaces by sealing the surfaces with a composition comprising vinylidene chloride acrylate copolymer. The cited portion of Jochmann discloses an aqueous dispersion comprising a vinylidene chloride-acrylate copolymer, and a non-ionic surfactant based on an alkyl-phenol-ethoxylate with a proportion of 10 moles of ethylene oxide per mole of the alkylphenoethoxylate, a vinyl pyrrolidone-copolymer or a diurethane and a defrothing agent, preferably a paraffinic mineral oil in combination with a hydrophobic component and a silicone polymer.

Instant claims 10 and 11 relate to an impact modifier comprising ethoxylated sorbitan ester and mineral oil. It is unclear which element in Jochmann the Examiner believes corresponds to the instantly claimed ethoxylated sorbitan fatty acid ester. Sorbitan contains a furan ring, which is a five-member heterocyclic compound containing oxygen in the ring. Jochmann discloses an alkyl-phenol ethoxylate, a vinyl pyrrolidone copolymer and a diurethane. Phenol is a six member aromatic ring (i.e., benzene) with a hydroxyl group attached. Pyrrolidone is a five member heterocyclic compound with nitrogen in the ring and oxygen double-bonded to a ring carbon. Diurethane is a condensation product of two urethane molecules, wherein neither the reactants nor the products contain a ring of any kind. Hence, Jochmann does not disclose all of the elements of claims 10 or 11.

Based on these distinctions, it is respectfully submitted that the *prima facie* case of anticipation fails, and claims 10-11 are patentable over Jochmann, and a notice to that effect is respectfully requested.

### **CONCLUSION**

In light of the foregoing, it is respectfully submitted that the present application, including claims 1-13, is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Because this is a first action, and no claims have been allowed, it is believed that the Status indicated on the Office Action cover sheet, namely, that prosecution on the merits is closed under *Ex parte Quayle*, indicated by a mark in block 3, is in error. The present amendment is written as though block 3 had not been marked.

It is expressly noted that claims 7-9 and 12-13 have not been rejected over any prior art.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 06-0625, our Order No. FER-14205.

Respectfully submitted,

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